

Express Mail Label
No. EV233502685US

UMO 1521.1
PATENT



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Application of James T. English et al.

Serial No. 09/829,549

Filed April 10, 2001

Confirmation No. 8198

For PHAGE DISPLAY SELECTION OF ANTI FUNGAL PEPTIDES

Examiner Teresa D. Wessendorf

Group Art 1639

RECEIVED
APR 04 2003
TECH CENTER 1600/2900

March 26, 2003

RESPONSE TO RESTRICTION REQUIREMENT

COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231

SIR:

This letter is in response to the Office action dated February 25, 2003, in which an election of a Group of claims and an election of species for prosecution on the merits was requested.

According to 35 U.S.C. §121, a restriction is proper only if there are at least two independent and distinct inventions. Furthermore, "[i]f the search and examination of an entire application can be made without serious burden, the Examiner must examine it on the merits, even though it includes claims to distinct or independent inventions." MPEP §803 (emphasis added). No showing has been made by the Office that the search and examination of this entire application will require serious burden. Instead, the Office asserts that the "[t]he inventions I and VI are unrelated" and that "[i]nventions II, III, IV and V are unrelated." Furthermore, the Office asserts that the former inventions are unrelated because they are drawn to different methods, and that the latter inventions are unrelated because they are drawn to structurally different compounds.

Claims 1-9 of Group I relate to a method for identification of non-immunoglobulin peptides having an affinity for the surface of fungi, whereas claims 23-31 of group VI relate to a method for screening peptides for the ability to affect development of a fungus. Applicants note that the claims of groups I and VI differ only in the last several steps, and can be searched without serious burden to the Office. Claims 10-13 of Group II relate to a composition comprising at least one substantially purified antifungal peptide selected from the listed sequences; claims 14-17 of group III relate to polynucleotide sequences encoding the peptides of group II; claims 18-21 of group IV relate to an expression cassette comprising a polynucleotide sequence of group III; and claim 22 of group V relates to a transgenic plant comprising the expression cassette of group IV. Accordingly, Applicants note that the claims of groups I and VI and groups II-V are related, and respectfully request rejoinder of group I and group VI claims, and rejoinder of group II, group III, group IV and group V claims.

Subject to the foregoing traverse, applicants hereby elect the claims of Group I (claims 1-9) for further prosecution.

Furthermore, in response to Examiner's request to elect a single disclosed species from each of the subgroups A and B, and pursuant to M.P.E.P. §809.02(a), Applicants elect type 8 vector of claim 4 (subgroup A) and random oligonucleotide GCA GNN (NNN)₇ of claim 5 (subgroup B). Claims 1-9 and claims 26-31 read upon the elected species.

According to M.P.E.P. §809.02(c), an examiner's action subsequent to an election of species should include a complete action on the merits of all claims readable on the elected species and according to M.P.E.P. §809.02(e), whenever a generic claim is found to be allowable in substance, action on the species claims shall thereupon be given as if the generic claim were allowed. Thus, if it is determined that the elected species is patentable, it is incumbent upon the Office to search additional species that fall within any allowable generic claims.

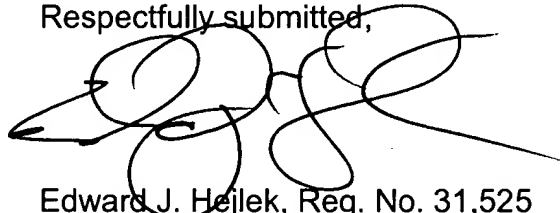
Applicants reserve the right to file divisional applications directed to the non-elected subject matter.

Express Mail Label
No. EV233502685US

UMO 1521.1
PATENT

Enclosed is a check in the amount of \$55.00 in payment of a one month extension of time under 37 C.F.R. §1.136(a). The Commissioner is hereby authorized to charge any underpayment or credit any overpayment to Deposit Account No. 19-1345.

Respectfully submitted,

A handwritten signature in black ink, appearing to read 'Edward J. Hejlek', written over the typed name.

Edward J. Hejlek, Reg. No. 31,525
SENNIGER, POWERS, LEAVITT & ROEDEL
One Metropolitan Square, 16th Floor
St. Louis, Missouri 63102
(314) 231-5400

EJH/axs